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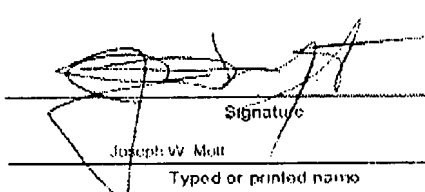
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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 54593-2 ORD	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name <u>Joseph W. Mott</u>		Application Number 10/625,282	Filed 07-22-2003
		First Named Inventor Frederick G. Payne	
		Art Unit 3652	Examiner Basil Katcheves
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.  This request is being filed with a notice of appeal.  The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>35,621</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34 Registration number if acting under 37 CFR 1.34 _____		 Signature Joseph W. Mott Typed or printed name 602-262-5866 Telephone number October 15, 2007 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
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OCT 15 2007

## PRE-BRIEF HEARING STATEMENT BY APPLICANT

Applicant respectfully submits that the rejections set out in the Office Action dated May 3, 2005, are clearly not proper. The Section 102 rejection of claims 1-5 and 10 over the Assouline reference is based on an unsupported misreading of what Assouline discloses. Applicant's claim 1 recites:

1. A method of discouraging the roosting or nesting of birds on structures comprising the steps of identifying roosting zones on the structure and applying thereto a slide comprising a formed sheet of material having a slick outer face and mounted to impose a plurality of angled slide surfaces that inhibit a bird's standing.

The Examiner's rejection of Claim 1 stems from a misreading of the claim coupled with a misunderstanding of what Assouline discloses. Claim 1 calls for applying a slide to the identified roosting zone. "Slide" is a defined term, meaning "a sheet of material having a slick outer surface and mounted at an angle so that a pigeon slides downward under the force of gravity and cannot stand still on the surface without effort" [Specification, ¶19]. The slide of Claim 1 is mounted to "impose a plurality of angled surfaces." Assouline does not disclose application of a slide to roosting zones. Indeed, Assouline teaches away from applying a slide, indicating that "inclined planes or strips of triangular shape with the point upward" are not a panacea [Col 1, 131-46]. Instead, Assouline teaches applying a series of polyhedrons with pointed tops and transparent lateral faces. According to Assouline, the optical phenomenon, particularly by refraction caused by the orientation of the faces and the transparent material, frightens the birds so they do not land there. Nevertheless, the Examiner says the structure of the reference anticipates the claims regardless of the teaching.

The examiner erroneously points to what he thinks is a slide sheet at Fig 1:7 and Fig 4:2 of Assouline. These are decidedly not "slide sheets," and the bird never touches them or slides on them. As described by Assouline, item 2 is a support base on which the successive transparent polyhedra are fitted [Col 2, 160-62] and item 7 is a bridge flange that connects two polyhedra [Col 2, 163-65]. The polyhedra bases are "less than 3 centimeters apart" [Col 3, 19-11], so no bird can set foot on the flange or base between the polyhedra. A fortiori, no bird can

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slide downward under the force of gravity at these locations. The Examiner also incorrectly identifies item 4 of Assouline's Fig 2 as "angled slick outer faces" corresponding to Applicant's "plurality of angled slide surfaces that inhibit a bird's standing." First, nothing in Assouline suggests that the outer surfaces of the polyhedron should be "slick." The crux of Assouline's disclosure is that the polyhedra faces be transparent so they create an optical effect that frightens birds [Col 3, l 13-14 ("The material used can be of any nature provided it exhibits faces able to give a prism effect")]. The Examiner's contention [OA p.5] that any diagonally sloped surface meets the limitation "slick" is spurious and must be disregarded.

Thus, the limitations "slide sheet" and "slick outer surface" are not present in Assouline.

Claims 2-5 and 10 depend from Claim 1 and are not anticipated where Claim 1, as shown, is not anticipated. Regarding Claims 3 and 5 (both of which include a "triangular prism"), Applicant respectfully submits that the Examiner misapprehends the standard terminology of solid geometry. By universally-known convention, a "prism" is a polyhedron with two congruent, parallel faces (called the bases) and whose lateral faces are parallelograms. A "triangular prism" is a prism whose bases are triangles. Applicant's Fig 4A shows a triangular prism; side 126 (and the other two sides) are parallelograms, and bases 129 and 130 (which may optionally be open or closed [Specification ¶1024]) are triangles. Triangular prisms are also shown in Applicant's Fig 2, items 114 and 115. No such shape appears anywhere in the disclosure of Assouline. The Examiner's contention [OA p.5] that this limitation is met by "anything shaped to break down the light spectrum" refers to optical prisms, not geometric ones. No possible reading of Applicant's claims in light of the specification suggests that optical prisms are claimed, and Assouline clearly does not disclose the geometric shape limitation.

With respect to Claim 10 ("partial pyramid"), the Examiner says [OA p.3] that Assouline shows a partial pyramid because one could extend the lines of the pyramid (Fig. 1, item 5, which is described as a "quadrilateral surmounted by a pyramid," Col 2, l 27-28) out to make a larger pyramid, so the disclosed pyramid is a partial one. This is tantamount to saying that because any geometric figure can be expanded, the figure itself is both an entire and a partial version of the geometric shape; such nonsense makes the term "partial" a nullity. Applicant's partial pyramid

shapes are disclosed in Fig. 2, items 112 and 113 and described at Para. 0022. They are in no way anticipated by Assouline's item 5.

The rejection of Claims 11 and 12 as obvious over Assouline exhibits plain error. (Claim 12 depends on claim 11 and is valid because claim 11 is valid.) Claim 11 recites:

11. A method of discouraging the nesting or roosting of birds on rooftop structures comprising the steps of identifying roosting zones on the rooftop structure and applying thereto a slide comprising a sheet of material having a slick outer surface and mounted to impose an angled surface that inhibits a bird's standing, wherein the slide comprises a sheet that follows a slope of the rooftop structure and covers the roosting zone.

In making the rejection of Claim 11 over Assouline as modified by an "obvious design choice," the Examiner must meet the standard for relying on common knowledge to augment a reference. This is permissible only where the modification is "capable of instant and unquestionable demonstration of being known" MPEP 2144.03(A). The addition of an element cannot be justified as based on "good common sense." *In re Zurko*, 258 F.3d 1379 (Fed Cir 2001).

Claim 11 calls for, *inter alia*, applying to the roosting zone a slide (a slick sheet mounted to impose an angled surface) comprising "a sheet that follows the slope of the rooftop structure." As explained in the specification, the natural slope of the roofline provides the slant or angle leaving the slick surface unsuitable for roosting [Specification ¶ 0029 and Fig. 7]. The Examiner's statement that "Assouline discloses the basic claim structure of the instant application" [OA p.1] is fatally defective. In the first place, as demonstrated above, Assouline does not disclose a sheet having a slick outer surface at all. Assouline discloses a multitude of pyramid protrusions with transparent faces closely bunched side-by-side. Moreover, nothing in

Assouline even hints at applying a sheet that follows the slope of the rooftop. Indeed, there is no suggestion whatsoever that any of the angled pyramid surfaces (e.g., surface 4 in Fig. 1) should follow any roofline. The purpose of the orientation of the faces is to create an optical phenomenon [Col. 2, 112-14], which is completely unrelated to any roofline. Thus, the contention that it would be an obvious design choice to apply Assouline's structure so that its "angled dimensions" follow the roof slope is nonsensical. The statement that the choice is obvious because there is no claimed criticality of a particular slope is a red herring, as Assouline gives no suggestion about any slope whatsoever.

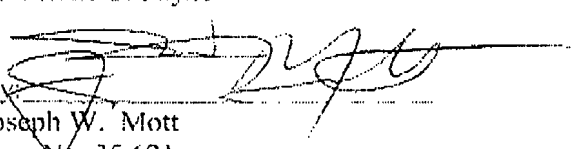
Finally, the Examiner's argument [OA, P. 6] that the rooftop is not claimed as part of the invention, so the slope of the rooftop cannot be a limitation is plain error. This is a method claim, and placing the slide on the rooftop so that it follows the slope of the rooftop (to inhibit a bird from standing) is part of the method. The limitation cannot be disregarded or nullified.

For the foregoing reasons, the application should be allowed on the existing claims.

Respectfully submitted,

Frederick G. Payne

October 15, 2007

  
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